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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,766	01/12/2001	Mohsen Shahinpoor	2359-00	4964

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EXAMINER

BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

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DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,766

Applicant(s)

SHAHINPOOR ET AL.

Examiner

Javier G. Blanco

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3,7-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of **Mini-bridges**: Species E (Figure 9), **Synthetic muscle**: Species A (list of polymers claimed in claim 6), and **Surgical instrument**: Species A (syringe) in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 3, 7-9, and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Claim Objections

3. Claims 12 and 14 are objected to because of the following informalities:
 - a. Regarding claim 12, for reasons of clarity, please substitute "the eye lens" (see line 7) with --the natural crystalline lens--. Appropriate correction is required.
 - b. Regarding claim 14, please substitute "The" (see line 1) with --A--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3738

5. Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 12, "an augmented contraction force" (see line 7) lacks antecedent basis.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 2, 4-6, 10, and 18-20 are rejected under 35 U.S.C. 101 because they are drawn to non-statutory subject matter.

In claim 1, lines 3-4, and claim 18, lines 3-4, applicants positively recite part of a human, i.e. "at least one bridge affixed to the at least one set of zonular fibers". Thus claims 1, 2, 4-6, 10, and 18-20 include a human within their scope and are non-statutory.

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. In re Wakefield, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3738

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 12-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Banko (US 4,253,199; cited in Applicants' IDS).

As seen in Figures 1-8, Banko discloses the method of correcting presbyopia and hyperopia (see claim 1; see column 1, lines 37-39), the method comprises the steps of (i) relaxing the ciliary muscle (inherent since local anesthesia is used), (ii) affixing at least one bridge (e.g., lip/flap 33, or, sub-flaps 76) to at least one set of zonular fibers (e.g., sutures 35; see column 3, lines 26-28), (iii) transmitting a contraction force from the ciliary muscle to the at least one set of zonular fibers and the at least one bridge, and (iv) constricting the eye lens by an augmented contraction force from the at least one set of zonular fibers and the at least one bridge (see column 3, lines 26-37; see claim 1; see entire document).

10. Claims 12, 14, 16, and 17 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Ganem et al. (WO 00/40174 A1).

As seen in Figures 1, 2, 4, and 5A, Ganem et al. disclose the method of correcting presbyopia and hyperopia (see claims 1; see page 1, lines 28-30), the method comprises the steps of (i) relaxing the ciliary muscle (inherent since local anesthesia is used), (ii) affixing at least one bridge (e.g., ring/device 20) to at least one set of zonular fibers (e.g., zonules 18c), (iii) transmitting a contraction force from the ciliary muscle to the at least one set of zonular fibers and the at least one bridge, and (iv) constricting the eye lens by an augmented contraction force from the at least one set of zonular fibers and the at least one bridge (see page 3, lines 11-15; see claim 1; see entire document).

Art Unit: 3738

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Langerman (US 4,888,016), Callahan et al. (US 6,096,077), Ganem et al. (US 6,494,910), Zhou et al. (US 6,506,212), Tourrette (FR 2 794 965), and Tourrette (FR 2 837 694).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 703-605-4259. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

January 20, 2004



David H. Willse
Primary Examiner